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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/578,664	05/25/2000	William Reeves		5874

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EXAMINER

GILLIGAN, CHRISTOPHER L

ART UNIT PAPER NUMBER

3626

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/578,664

Applicant(s)

REEVES, WILLIAM

Examiner

Luke Gilligan

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 89-108 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 89-108 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Response to Amendment***

1. In the amendment filed 1/21/05, the following has occurred: no claims have been added, canceled, nor amended. Now, claims 89-108 are presented for examination.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 107-108 are rejected under 35 U.S.C. 102(e) as being anticipated by DeLaHuerger, U.S. Patent No. 6,408,330.
4. Claims 107 and 108 are rejected for the same reasons as given in the previous office action, mailed 9/23/04, incorporated herein by reference.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 89-106 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ross, Jr. et al., U.S. Patent No. 5,823,948 in view of DeLaHuerger, U.S. Patent No. 6,408,330.

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7. Claims 89-106 are rejected for the same reasons as given in the previous office action, mailed 9/23/04, incorporated herein by reference.

***Response to Arguments***

8. In the remarks filed 1/21/05, Applicant argues in substance that (1) DeLaHuerga does not teach any means for inputting nor authenticating medical records, clinical data, nor any other data; (2) DeLaHuerga only makes reference to a single user of an ICD that will be assigned a single identifier to authenticate a single user unlike the plurality of users recited in the claims; (3) there is no motivation from the references to combine DeLaHuerga and Ross; (4) there is no suggestion that the combination of DeLaHuerga and Ross would have a reasonable expectation of success; (5) the watermark in DeLaHuerga is unrelated to the recited digital physician signature.

9. In response to Applicant's argument (1), it appears that Applicant is referencing features that are recited in the preamble of claims 107 and 108. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In this case, although the claims recite a computer system and process for inputting, authenticating, etc., because the elements and steps recited in the body of the claims can stand alone, independent of the described statement of purpose, the preamble has not been given any patentable weight.

10. In response to Applicant's argument (2), the Examiner agrees with Applicant that, in the preferred embodiment of DeLaHuerga, a single ICD is assigned to and used to authenticate a

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single user. The Examiner, however, does respectfully point out that, in an alternative embodiment, a plurality of users can use a single ICD to access the system (see column 19, lines 57-60). Nevertheless, DeLaHuerga makes it clear that the described system is intended to be used in the context of a medical facility in which various types of physicians can access patient records (see column 17, lines 20-35). Therefore, although DeLaHuerga describes the authentication with respect to a particular user using their ICD, this is clearly the same process that is used for each physician using the system.

11. In response to Applicant's argument (3), the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, DeLaHuerga not only identifies problems with data security in healthcare facility environments (see column 14, lines 4-14), but also identifies the use of digital physician signatures as a means for enhancing security for sensitive information (see column 15, lines 14-21). Therefore, it is respectfully submitted that one of ordinary skill in the art of patient record management at the time of the invention would have been motivated to look to other data security techniques, such as those described by DeLaHuerga.

12. In response to Applicant's argument (4), the Examiner respectfully submits that the combination Ross and DeLaHuerga, as applied above, would have had a reasonable expectation of success. Both references are directed to electronic medical records management and both references identify data security concerns of sensitive information. Furthermore, the Examiner respectfully notes that the test for obviousness is not whether the

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features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). It is, therefore, respectfully maintained that the combined teachings of Ross and DeLaHuerga, as detailed above, would have suggested, to one of ordinary skill in the art, the claimed invention.

13. In response to Applicant's argument (5), the Examiner respectfully submits that DeLaHuerga uses the term "watermark" to describe a form of digital signature that is used for subsequent signature authentication as well as document authentication (see column 13, lines 4-10 and column 15, lines 27-35). It is further submitted that Applicant's provided definition of a "watermark" from Webster's dictionary is not relevant to the "watermark" described by DeLaHuerga. Additionally, contrary to Applicant's assertion, DeLaHuerga does not merely teach that the watermark is "examined." Rather, DeLaHuerga describes a process of decrypting the watermark and using the corresponding digital signature to authenticate a particular document (see column 15, lines 36-45). Therefore, it is respectfully submitted that the described "watermark" of DeLaHuerga is a form of digital signature as recited in the claims.

### ***Conclusion***

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

15. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after


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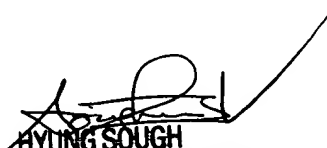
the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke Gilligan whose telephone number is (571) 272-6770. The examiner can normally be reached on Monday-Friday 8am-5:30pm.

17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
CLG  
4/29/05

  
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